

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte IMANTS R. LAUKS and JOSEPH W. ROGERS

Appeal No. 1998-1786
Application No. 08/486,150¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, MEISTER
and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 36, 38 through 46 and 67 through 69. Claims 47 through 50 and 70 have been objected to as depending

¹ Application for patent filed June 6, 1995. According to the appellants, the application is a division of Application No. 08/144,966, filed October 28, 1993, now abandoned.

from a non allowed claim. Claims 1 through 35, 37 and 51 through 66 have been canceled.

We AFFIRM, however, for reasons explained infra, we denominate our affirmance a new ground of rejection under 37 CFR § 1.196(b).

BACKGROUND

The appellants' invention relates to a fluid sample collection device (claims 36 and 38 through 46) and a method of collecting fluid samples with a fluid sample collection device (claims 67 through 69). An understanding of the invention can be derived from a reading of exemplary claim 36, which appears in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Diamond et al. 1981 (Diamond)	4,272,245	June 9,
White 1983	4,393,882	July 19,
Kelley 1993	5,257,984	Nov. 2,

(filed Oct. 2, 1991)

Claims 36, 38, 39 and 41 stand rejected under 35 U.S.C. § 103 as being unpatentable over White.

Claim 40 stands rejected under 35 U.S.C. § 103 as being unpatentable over White in view of Kelley.

Claims 42 through 46 and 67 through 69 stand rejected under 35 U.S.C. § 103 as being unpatentable over White in view of Diamond.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection (Paper No. 8, mailed December 12, 1996), the examiner's answer (Paper No. 14, mailed January 5, 1997) and the supplemental examiner's answer (Paper No. 17, mailed February 2, 1999) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 13, filed

November 12, 1997), reply brief (Paper No. 15, filed March 5, 1998) and communication (Paper No. 18, filed February 9, 1999) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims², to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

We have selected claim 36 as the representative claim from the appellants' grouping of claims 36, 38-46, and 67-69 to decide the appeal on the rejections under 35 U.S.C. § 103. See page 5 of the appellants' brief. In addition we note that the appellants have not challenged the rejections of claims

² The following terms used in the claims under appeal lack proper antecedent basis: the reservoir chamber (claims 36, 38, 40, 41, 43, 45, 49, 50, 67 and 69), the receiving means (claims 38, 39 and 67), the housing (claims 43, 49, 50 and 68), the second end (claim 48), and the fluid delivery system (claim 67).

40, 42 through 46 and 67 through 69 with any reasonable specificity, thereby allowing those claims to fall with claim 36 (see In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987)).

With respect to claim 36, the examiner first determined³ (final rejection, p. 2) that White teaches "a fluid sample collection device as claimed by applicant, except the luer fitting is male rather than female." The examiner then determined (final rejection, p. 2) that

[i]t would have been obvious to one of ordinary skill in the art to use a female luer fitting rather than a male [luer fitting] as they are freely interchangeable among elements to be joined together.

The appellants in their brief (pp. 7-11) and reply brief (pp. 3-6) provide arguments as to why one of ordinary skill in the art would not have changed White's female luer fitting to a male luer fitting. We agree. In that regard, there is no suggestion or motivation in the applied prior art (i.e., White, Kelley and Diamond) to have modified White's female

³ The appellants have not contested this determination of the examiner.

luer fitting (i.e., White's tip section 11b; see column 4, lines 24-27) to a male luer fitting.

However, for the reasons set forth below, it is our determination that White does teach a female luer fitting adapted to his housing. A disclosure that anticipates under 35 U.S.C.

§ 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974).

White discloses a device for collecting, transporting, and delivering micro samples of blood. As shown in Figures 1 and 2, the device 10 includes an adapter-handle 11, a needle assembly 12, and a microcapillary tube 13. These components may be supplied to the user in assembled form as shown, or they may be supplied as separate parts to be assembled by the user. In either case, a suitable cover 14 should be attached

to the needle 12 to maintain sterility of the needle until use. An end cap 15 may be fitted upon the distal end of the capillary tube, and the entire assembly may be supplied in sterile condition within a suitable wrapper (not shown).

White teaches (column 3, lines 52-65) that the adapter-handle 11 is formed from a relatively soft resilient elastomer and is composed of integral body and tip sections 11a and 11b, respectively. A bore 21 extends through the adapter with that portion 21a of the bore within body section 11a tapering gradually inwardly for receiving and frictionally retaining one end of microcapillary tube 13. The gradual taper of bore portion 21a and the resiliency of the material from which the adapter is formed not only insure that a tight frictional seal will be formed between the end of the capillary tube and the adapter but also permits the adapter to form such engagement with standard capillary tubes of different diameters and capacities.

White further teaches (column 4, lines 15-21) that

[i]n some cases it may be desirable to draw a larger sample of arterial or venous blood and for that purpose the tapered bore of the body section 11a may be stepped outwardly to provide an enlarged entrance portion 21b. Bore portion 21b has a Luer taper similar to that of hub cavity 18 and, consequently, is adapted to mate with the Luer tip of a standard syringe.

Thus, White does teach a female luer fitting (i.e., bore portion 21b) adapted to his housing. Accordingly, we sustain the examiner's rejection of appealed claim 36, and claims 38 through 46 and 67 through 69 which fall therewith, under 35 U.S.C. § 103 since anticipation is the epitome of obviousness.

Since our rationale for affirming the examiner's rejections under 35 U.S.C. § 103 is different from that of the examiner, we denominate our affirmance a new ground of rejection under 37 CFR § 1.196(b).

CONCLUSION

To summarize, the decision of the examiner to reject claims 36, 38 through 46 and 67 through 69 under 35 U.S.C. § 103 is affirmed, however, for reasons explained supra, we have

denominated our affirmance a new ground of rejection under 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED; 37 CFR § 1.196(b)

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
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)	
)	
)	BOARD OF PATENT
JAMES M. MEISTER)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

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APPEAL NO. 1998-1786 - JUDGE NASE
APPLICATION NO. 08/486,150

APJ NASE

APJ MEISTER

SAPJ McCANDLISH

DECISION: **AFFIRMED;**
37 CFR § 1.196(b)

Prepared By: Gloria Henderson

DRAFT TYPED: 29 Apr 99

FINAL TYPED: